

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 30, 2009. At the time of the Office Action, Claims 1, 4-9, 12-17, and 20-25 were pending in this Application. Claims 1, 4-9, 12-17, and 20-25 were rejected. Claims 1, 9, 17, and 25 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1, 4-9, 12-17, and 20-25 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant traverses the rejections and respectfully request allowance of Claims 1, 4-9, 12-17, and 20-25 as amended.

With respect to Claims 1, 9, 17, and 25, the Examiner states that Applicant has not defined how to determine if a provider is satisfactory or how to rank those that are satisfactory. Applicant respectfully disagrees. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Accordingly, a term may be enabled even if it can be applied in many different ways, and a person of skill in the art would recognize from the specification specific ways in which a provider is satisfactory or ranked. Numerous times, cost is cited in the specification as a possible criteria for evaluation. For example, “Organization agent 22 may continue [ranking new against existing services] at any appropriate times to help ensure that organization 14 continues to receive the most cost effective... supply services.” Page 10:21-11:2. Similar examples, in regards to cost, are given for travel services and payroll services. Page 11:21-23; 8:27-30. In purchasing, bids may be arranged “based upon cost, delivery time, or other suitable criteria.” Page 20:3-5. In terms of cost, a person of skill in the art would understand how to determine satisfaction and rank service providers: from low cost to high cost. Different, but valid suitable criteria may be required for a particular application. However, one of skill in the art would understand how to correctly rank the criteria she wishes to apply. The fact that the current disclosure does not explicitly discuss how all

criteria may be ranked does not foreclose one with skill in the art from applying the present disclosure. Thus, Applicant has sufficiently described how to determine if a provider is ‘satisfactory’ and how to rank those that are satisfactory. Accordingly, Claims 1, 9, 17, and 25 comply with the enablement requirement, and Applicant respectfully requests the Examiner to withdraw the rejection and allow these claims.

With respect to Claim 9, the Examiner states that Applicant’s disclosure does not disclose how an “agent” establishes a database. In context, Claim 9 recites that “an organization agent . . . establish[es] an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements” (emphasis added). As example support for this type of function, the specification recites: “organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors.” P. 8, ll. 18-19. One of ordinary skill in the art would know about the existence and use of databases; Examiner’s arguments regarding the obviousness of the database limitation say as much. Office Action at ¶¶33-35. As discussed above, the present disclosure speaks of the functions that must be accomplished by the database. One of skill in the art would not require undue experimentation to apply his knowledge of databases to the teachings of the disclosure to arrive at the claimed invention. Applicant respectfully submits that one of ordinary skill in the art would be able to establish a database containing the information as specified by Applicant based on the description provided in the claims and specification.

Claims 9 and 12-16 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner argues with respect to Claim 9’s “organization agent” that the system components or structure is not claimed such that one understands the structure required to carry out these steps. Applicant respectfully submits, however, that Claims 9 and 12-16 are definite without amendment because the meaning of these claims would be clear to one of ordinary skill in the art. See M.P.E.P. § 2173.02. Breadth of a

claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Accordingly, a term is not indefinite merely because it lacks structural elements; rather, terms may take the plain and ordinary meanings that are consistent with the specification.

In Claim 9, the plain and ordinary meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification. For example, Applicant’s specification recites: “Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors.” P. 8. The specification also recites: “Interface 42 provides a link between agent 40 and other entities within system 10. Depending upon the particular types of communications and configurations within system 10, interface 42 may include any suitable combination of hardware and/or logic for interacting with other components.” P. 15. Moreover, the claim language itself recites “an organization agent coupled to the service providers and the service registry using a communication network.”

In addition, external evidence supports that one of ordinary skill in the art would understand the plain and ordinary meaning of the phrase. For example, the definition of “agent” is given as “a computer application designed to automate certain tasks (as gathering information online).” *Merriam-Webster Collegiate Dictionary*, Merriam-Webster, 11th. Ed.

Because the meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification, Applicant submits that Claims 9 and 12-16 are definite and comply with 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests the Examiner to withdraw the rejection and allow these claims.

Rejections under 35 U.S.C. § 101

Claims 1, 4-9, and 12-16 were rejected by the Examiner under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 9 have been

amended. Applicant traverses the rejections and respectfully request allowance of Claims 1, 4-9, and 12-16 as amended.

Under the rule recently enunciated in *In re Bilski*, an invention is patent-eligible if it (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, No. 2007-1130, slip op. (Fed. Cir. October 30, 2008). Under this rule, a patent-eligible process cannot be purely a fundamental principle (law of nature, natural phenomena, or abstract idea) or a purely mental process. *Id.* at 7.

With respect to Claims 1 and 4-8, Claim 1 is tied to a particular machine or apparatus. This is clearly illustrated by the limitation, “identify a network address for each of a plurality of service providers.” The service providers have a network address, and are thus clearly tied to a particular machine or apparatus. Claim 1 also contains the limitations, “wherein the service registry and each of the plurality of service providers are coupled to a communications network,” further demonstrating that the service registry and service providers are tied to a particular machine or apparatus. This is fully supported by the specification, which states, “Thus, system 10 contemplates services 18 including any suitable combination of *hardware* and/or logic and the functionalities of services 18 being incorporated in and/or provided by any suitable network accessible *equipment*.” Page 17:23-25. These steps clearly recite a particular machine or apparatus. Claim 1 is thus allowable subject matter under 35 U.S.C. § 101. Claims 4-8 depend upon Claim 1, and are thus similarly allowable.

With respect to Claims 9, 12-16, the Examiner argues that the claimed service providers are not patent-eligible because they encompass human beings. Applicant respectfully disagrees. Claim 9, as amended, contains the limitations “a plurality of service providers each having a *network address* and *coupled to a communication network*” (emphasis added). Network addresses can only be assigned to a physical machine, and only a machine can be coupled to a communication network. The context of Claim 9, in which network addresses are repeatedly referenced for registration, identification, communication, indicates that the only reasonable interpretation of a service provider is a machine. This is fully supported by the specification, which states, “Thus, system 10 contemplates services 18 including any suitable combination of

hardware and/or logic and the functionalities of services 18 being incorporated in and/or provided by any suitable network accessible *equipment*.” Page 17:23-25. Thus the phrase “service providers,” as used by Applicant, does not encompass human beings. Claim 9 is thus allowable subject matter under 35 U.S.C. § 101. Claims 12-16 depend upon Claim 9, and are thus similarly allowable.

Applicant respectfully request full allowance of Claims 1, 4-9, and 12-16.

Rejections under 35 U.S.C. § 103

Claims 1, 4-7, 9, 12-15, 17, 20-23, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0023499 filed by Rajarshi Das (“Das”) in view of U.S. Patent Application Publication 2001/0051913 filed by Avinash Vashistha (“Vashistha”). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 8, 16, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Das* in view of *Vashistha* in further view of U.S. Publication No. 2002/0184527 filed by Jon Andre Chun et al (“Chun”). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

A. Claims 1, 4-7, 9, 12-15, 17, 20-23, and 25 are patentable over *Das* and *Vashistha*.

Consider Applicant’s independent Claim 1, as amended, which recites:

A method for automated management of business services comprising:

establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;

accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator, wherein the service registry and each of the plurality of service providers are coupled to a communications network;

for each of the identified service providers:

communicating with the service provider to determine feature interfaces for interacting with the service provider, the service provider providing at least techniques for interfacing with the feature interfaces;

accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;

determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and

if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider;

ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers; and

accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider, the service descriptors comprising at least techniques for interfacing with the feature interfaces. Support for the limitation, “the service descriptors comprising at least techniques for interfacing with the feature interfaces,” may be found on Page 6:28-30 of the application. The application also states, when describing elements of a service, that “description 54 may include information describing service 18, identifying functions provided by service features 52, and *detailing mechanisms for accessing and interfacing with feature interfaces 56.*” Page 16:11-12 (emphasis added). The application goes on to state that, “This information [provided to organization agent]... may include... general message structures for interfacing with service 18...” Page 16:18-20.

Nothing in *Das* nor *Vashistha* teach that a service descriptor may comprise techniques for interfacing with the feature interfaces. *Das* and *Vashistha* are silent as to how an organization may learn from a service which modes of interfacing will be used.

Independent Claims 9, 17 and 25 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, 17 and 25, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, 17 and 25 and their respective dependent claims.

B. Claims 8, 16, and 24 are patentable over *Das*, *Vashistha*, and *Chun*.

As described above, Applicant has shown that *Das* and *Vashistha* fail to disclose all limitations of independent Claims 1, 9, and 17. Accordingly, *Das* and *Vashistha* fail to teach or

suggest all limitations of Claims 8, 16, and 24 because these dependent claims incorporate the limitations of their respective independent claims. *Chun* fails to remedy the deficiencies of *Das* and *Vashistha*.

Thus, *Das*, *Vashistha*, and *Chun*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 16, and 24. Because the references fail to teach all limitations of the claims, Applicant respectfully requests reconsideration and allowance of Claims 8, 16, and 24.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1, 4-9, 12-17, and 20-25 as amended.

Applicant believes there are no fees due at this time; however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.5470.

Respectfully submitted,

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